IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex Parte Hoffman et al.

Application for Patent: 09/587,092

Filed: May 31, 2000

Group Art Unit: 3693

Examiner: Borlinghaus, Jason M.

For:

SMART CARD TRANSACTIONS USING WIRELESS TELECOMMUNICATIONS NETWORK

REPLY TO EXAMINER'S ANSWER

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1. CLAIMS REQUIRE A MOBILE TELEPHONE HANDSET WITH BOTH A SMART CARD AND A SEPARATE SUBSCRIBER IDENTIFICATION MODULE (SIM)

In the Answer mailed September 17, 2008 it is suggested on page 11 at row 2 that the inter-sector electronic purse described at pages 328-342 of *Rankl* is a smart card that can be inserted into a mobile telephone handset. But, the disclosure of these pages (especially pages 336 and 337) is nothing more than the prior art that describes loading the electronic purse at a fixed terminal. There is no discussion that the electronic purse is part of, or meant to be used in a mobile telephone handset. Appellant submits that this portion of *Rankl* not be considered for the proposition that *Rankl* discloses a smart card present in a mobile telephone handset.

The Answer also suggests at page 14, first full paragraph, that the conventional telephone shown at page 343 may also be considered a mobile telephone handset in the interpretation of the claims. Appellant disagrees. Each of the independent claims clearly requires a mobile telephone handset in communication with a wireless telecommunications network and Figure 3 of the present application shows an example of a small, wireless, mobile telephone handset as understood in the art. By contrast, the figure on page 343 of *Rankl* clearly shows a conventional, heavy, large, corded telephone that is anything but mobile. Secondly, *Rankl* was first published in 1995 and Appellant submits that at that time it would be incorrect to assume that *Rankl* was disclosing a mobile telephone handset as required by the claims. Finally, the figure on page 343 discloses the entire telephone—the base unit with the handset on top—it does not disclose "just" a handset and it should not be referred to as simply "a handset."

The Answer suggests that it would have been obvious to one of ordinary skill in the art to combine the conventional telephone of the Mondex system that includes a card reader able to receive a smart card (shown at page 343) with the GSM mobile phone that includes a SIM (shown at page 363), in order to arrive at the mobile telephone handset of claim 1 (for example) that includes both a smart card and SIM.

Appellant submits that it would not be obvious because, for one, the smart card and SIM are not simply discrete elements that can be thrown together without further thought (*i.e.*, the claimed invention is not merely a combination of old elements). As is known in the art, (and as required by claims 1 and 5) the SIM is separate from the smart card and functions to allow a user to access the telecommunications network. Because value is being loaded onto the smart card of the handset over the wireless telecommunication network, the SIM must be involved in the communications back and forth. For example, claim 5 requires that the smart card is arranged to validate cryptographic certificates: an authorization request certificate is sent from the handset and the handset receives an authentication response certificate. Thus, the SIM is involved in sending and receiving these certificates that are processed by the smart card. Simply putting a SIM with a smart card without considering how they would interact would not work.

Secondly, there is no reason why the conventional Mondex telephone (page 343) would need a SIM. It is not a mobile telephone and there is no discussion in the reference of using a mobile telephone. Similarly, the GSM mobile phone (page 363) does not need a separate smart card (in addition to the SIM) because this phone is not being used to load value or for purchasing, and there is no such discussion.

For these reasons, it would not have been obvious to combine the conventional Mondex telephone with the GSM mobile phone.

2. IT IS NOT OBVIOUS TO COMBINE THREE SEPARATE TECHNOLOGIES

The Answer indicates at page 16, first full paragraph, that the Appellant has not refuted the assertion of obviousness. Appellant believes it has at: section heading 7.2; lines 1-5 at the top of page 8; the third full paragraph on page 9; and the paragraph spanning pages 9 and 10. Appellant stands by its arguments in the Appeal Brief as to why it would not be obvious to combine these separate technologies. Further, the Answer states at page 16 that each element merely would perform the

same function as it did separately. If each element merely performs its same function, a non-operating smart card loading system would result. For example, the smart card and card reader of the conventional telephone of the Mondex system (page 343) does not interact with a SIM; it would have to be reconfigured to do so. Further, the inter-sector electronic purse (pages 336 and 337) is only used in a standalone physical terminal. It also would have to be reprogrammed to interact with a SIM. Finally, the SIM of the GSM phone (at page 363) does not know how to interact with a separate smart card onto which value would be loaded.

3. USE OF SMS TEXT MESSAGES TO CONTROL A SMART CARD IS NOT OBVIOUS

Appellant stands by its arguments in the Appeal Brief and comments further.

The Answer at page 17, first full paragraph, states that "commands are sent through the telecommunication network to control operation of the smart card in the handset" and cites pages 336 and 337 of *Rankl*. Firstly, Appellant has pointed out above that this inter-sector electronic purse disclosure at pages 336 and 337 of *Rankl* only discusses a prior art standalone terminal and not a mobile telephone handset as required by the claims. Secondly, there is no telecommunications network disclosed, for the simple reason that the inter-sector electronic purse (embodied upon a smart card) is communicating with a security module (the PPSAM) within the terminal. As known in the art, the terminal is a larger unit placed on a counter or perhaps part of a kiosk. Therefore, Appellant disagrees with this language on page 17 of the Answer stating that a "telecommunications network" and a "smart card in a handset" are disclosed on pages 336 and 337 (or anywhere within the inter-sector electronic purse discussion ranging from pages 328 to 342).

This same first full paragraph on page 17 of the Answer also states that the commands sent to the smart card "are alphanumeric messages" such as "CREDIT IEP." Appellant disagrees. The alphanumeric commands listed in this section (such as CREDIT IEP, INITIALIZE IEP, KSES, S1, etc.) are simply easy to remember, human-readable variable names that represent the actual electronic commands that are

sent between the electronic purse and the security module. The characters "CREDIT IEP" are never actually sent to the electronic purse, they simply are an easy nomenclature to use when describing command flow. Consider for example the command "S1." These characters "S1" represent a complex, cryptographic digital signature of perhaps 64 bytes in length. The characters "S1" are never sent back and forth, it is the actual 64 bytes of electronic data that is sent back and forth. Therefore, Appellant disagrees with the statement on page 17 of the Answer that "The commands sent are alphanumeric messages (derived from a character set comprising letters and numbers), such as CREDIT IEP."

Finally, the Answer at pages 17 and 18 suggests that all SMS messages must first be received by a microprocessor before they can be read by a human. True, but Appellant is claiming that the SMS messages of claims 1, 7, 11 and 14 are being used as command input to a smart card used to control operation of that smart card. While a typical SMS message such as "HOW R U" is received and displayed under direction of a microprocessor, a message such as "HOW R U" would never have been used to control operation of a microprocessor.

4. CLAIM 12 REQUIRES A SECOND APPLICATION ON THE SMART CARD

The Answer at the bottom half of page 18 asserts that the limitations argued for claim 12 and Appellant's interpretation are somehow not proper. Appellant asserts that claim 12 was present in the application as filed, has support at page 15 of the present application, and that the claim makes clear that the source of funds comes from the second application on the card. No Office action has yet identified these steps in the prior art.

The top half of page 19 of the Answer asserts that the second application on the smart card is a "file containing global parameters" discussed at page 337 of *Rankl*. But, the cited paragraph does not mention any "file," only the existence of "global parameters." Finally, that cited paragraph makes clear that the source of funds is the money that the user pays into the terminal—an external source.

5. CONCLUSION

In view of the foregoing, it is respectfully submitted that the rejection is erroneous and it is requested that this rejection be reversed.

Respectfully submitted,
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